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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,632	05/01/2001	Andrew D. Dubner	56650US002	4391
32692	7590	08/22/2008		
3M INNOVATIVE PROPERTIES COMPANY				
PO BOX 33427				
ST. PAUL, MN 55133-3427				
EXAMINER				
FRIDIE JR, WILLMON				
ART UNIT		PAPER NUMBER		
3724				
NOTIFICATION DATE		DELIVERY MODE		
08/22/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

LegalUSDocketing@mmm.com

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# Office Action Summary

## Application No.

09/846,632

## Applicant(s)

DUBNER ET AL.

## Examiner

Willmon Fridie

## Art Unit

3724

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6, 9-16 and 18-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9-16 and 18-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date 6/18/08
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 2, 9, 12, 13, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stephens in view of Smith and Moraw et al.

Stephens inherently teaches the method in claims 23 and 24 and substantially all of the subject matter set forth in the claims except for the claimed layer materials and indicia on one of its transparent layers. Smith discloses that it is well known in the art to provide indicia on a transparent layer associated with an information bearing assembly (see column 2, lines 10-16). It would have been obvious to a skilled artisan at the time of the invention was made to provide Stephens with indicia (overt or covert) on one of its

transparent layers in the manner as taught by Smith in order to provide more information to the user. Stephens as modified by Smith lacks the disclosure of a fragile and durable layer. Moraw et al disclose "It can also be advantageous to protect the polyethylene films, which although firm are soft, with harder films. To achieve this, film laminates of polyester films with polyethylene films can be used for the outer covering layers." It would have been obvious to a skilled artisan to provide the transparent layers of Stephens as modified by Smith with polyester films to achieve a fragile and a durable layer in the manner as suggested by Moraw et al. in order to enhance the durability of the assembly.

With respect to claims 9 and 12, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the claimed material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Claims 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stephens as modified by Smith and Moraw et al as applied to claims 1,2,9,12,13, and 23-25 above, and further in view of Killey.

Stephens as modified by Smith and Moraw et al. discloses the claimed invention and substantially all of the subject matter set forth in the claims except for a holographic layer. Killey discloses and teaches that it is well known in the art to use a holographic foil layer in its assembly. It would have been obvious to a skilled artisan at the time of

the invention was made to provide Stephens as modified by Smith and Moraw et al. with a holographic layer in the manner as taught by Killey in order to enhance the security feature.

Claims 4,6,10,11,14-16,19,20, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stephens as modified by Smith and Moraw et al. as applied to claims 1,2,9,12,13 and 23-25 above, and further in view of McConville et al..

Stephens as modified by Smith and Moraw et al. discloses all of the subject matter set forth in the claims except for a retro reflective layer of glass beads. McConville discloses and teaches that it is well known in the art to use retro reflective layer of glass beads (24), hot melt adhesive (32), a protective coating lacquer coating and an index coating (26) in his assembly. It would have been obvious to a skilled artisan at the time of the invention was made to provide Stephens as modified by Smith and Moraw et al. with a retro reflective layer of glass beads, hot melt adhesive and a protective coating lacquer coating and an index coating (26) in the manner as taught by McConville et al. in order to enhance and protect the security feature. McConville et al. further teaches that it is well known in the art to use a composite assembly of the claimed elements in a document of value (see column 1, lines 25-65).

With respect to claims 20—22, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the claimed indicia (passport, ID card, document of value) since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held

that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an end user with a specific type of information document or form does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Therefore, it would have been obvious to place any type of indicia on the assembly, since applicant has not disclosed the criticality of such.

Claims 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stephens as modified by Smith and Moraw et al. as applied to claims 1,2,9,12,13,23 and 24 above, and further in view of Killey and McConville et al. It would have been obvious to a skilled artisan to provide Stephens as modified by Smith and Moraw et al. with a multi-layer optical film layer and a holographic foil layer in the manner as taught by McConville et al and Killey for the reasons stated in the previous paragraphs.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Willmon Friddle whose telephone number is 571 272 4476. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ASHLEY BOYER can be reached on 571 272 4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3724

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Wf  
/Willmon Fridie/  
Primary Examiner, Art Unit 3724